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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: G. I. Negueloua DATE: November 24, 2003

SERIAL NO: 09/784,693

GROUP ART UNIT: 3671

FILED: 02/15/2001

EXAMINER: Hartmann, Gary S.

FOR: "Improved Cap Sealer for Caulked Joints"

ATTORNEY DOCKET NO.: A00360US (98448.2)

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

BRIEF OF APPELLANT

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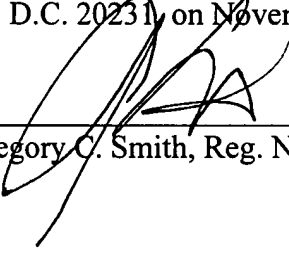
Dear Sirs:

On July 16, 2003, the Examiner finally rejected Claims 1-12 of the above-referenced patent application. A Notice of Appeal was filed on September 15, 2003, and was received by the USPTO on September 22, 2003. This brief, required by 37 C.F.R. § 1.192(a), is due on November 22, 2003 (Saturday) (see 37 C.F.R. § 1.8(a)(2) and MPEP § 512, last paragraph on pages 500-35 (6th ed., Rev. 1, Sept. 1995)); it is in the form required by 37 C.F.R. § 1.192(c).



CERTIFICATE OF MAILING

I hereby certify that **the original and two copies** of this Appeal Brief are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on November 24, 2003.



Gregory C. Smith, Reg. No. 29,441

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(1) REAL PARTY IN INTEREST:

G. I. Negueloua

(2) RELATED APPEALS AND INTERFERENCES:

None

(3) STATUS OF CLAIMS:

Claims 1 through 12 have were rejected under 35 U.S.C. § 103, as being unpatentable over Marble (U. S. Patent No. 2,016,968) in view of Jobe et al. (U.S. Patent No. 6,253,514) and Barton, et al. (U. S. Patent No. 5,088,260.)

Further claims 1 through 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Marble (U.S. Patent 2,016,968) in view of any of Hahn (U.S. Patent 6,228,507); Treister et al. (U.S. Patent 6,170,214); Negola et al. (U. S. Patent 6,161,353); Parkinson (U.S. Patent 5,715,643); Boyce (U. S. Patent No. 6,170,214); Negola et al. (U.S. Patent No. 6,161,353); Parkinson (U.S. Patent 5,715,643); Boyce (U.S. Patent 5,667,334); Speer et al. (U. S. Patent 5,460,115); Hughes (U.S. Patent 5,197,819); Montalbano (U.S. Patent 5,078,358); and/or Winter, IV (U.S. Patent 4,833,855).

The rejection of Claims 1 - 12 is being appealed.

(4) STATUS OF AMENDMENTS:

An amendment was filed on May 28, 2003, and was entered.

(5) SUMMARY OF INVENTION:

As suggested by MPEP § 1206, Applicant has read some of the appealed claims on the specification and drawings. These claims follow.

1. An improved cap (10) for sealed joints between adjacent blocks (30,32), comprising:
 - a) a flexible body member (12), comprising a first cap portion(14) and a leg portion(16);
 - b) a plurality of ridges (22) positioned on an underside (18) cap portion (14), having a plurality of channels (24) there between, the ridges (22) further defining an increased area on the underside of the cap (14)for sealant (38) to adhere to;
 - c) the leg portion (16) insertable into fluidized sealant material (38) within the joint (37) between the adjacent blocks (30,32), to a depth so that the underside of the cap portion imbeds into the sealant material (38) for providing a sealed connection between the underside (18) of the cap (14) and the fluidized sealant material (38) residing in the joint (34) and on an upper surfaces of the

adjacent blocks (30,32).

2. The improved cap (10) in claim 1, wherein the cap (14) is constructed of material having the characteristics of lead.
3. The improved cap (10) in claim 1, wherein the leg member (16) further comprises a pointed end (28) having shoulder members (29,30) for adhering within the sealant material (38.)
4. The improved cap (10) in claim 1, wherein the plurality of ridges (22) and channels (24) on the underside of the cap portion (14) define a means for adhering to the fluidized sealant (38) and the upper portion (31) of the adjacent blocks for withstanding movement and preventing damage to the sealed joint.
5. The improved cap (10) in claim 1, wherein the cap (14) may be positioned to seal a joint between horizontal and vertical surfaces.
6. An improved cap (10) for sealed joints between adjacent building members (31,32), comprising:
 - a) a flexible body member (12), comprising a first cap portion (14) having a first smooth upper surface (20), an undersurface (18), and a leg portion (16) extending down from the undersurface (18);
 - b) a plurality of ridges (22) positioned on the undersurface (18) of the cap portion (14), defining a plurality of channels (24) there between, the plurality of ridges (22) and channels (24) increasing the surface area on the underside (18) of the cap (10) by around 50% for the sealant (38) to adhere to, thus strengthening the seal between the cap (14) and the concrete or stone blocks (30,32) the cap (14) is set upon;
 - c) fluidized sealant material (38) placed within the joint between the adjacent building members (30,32) ;
 - d) the leg portion (16) insertable into the fluidized sealant material (38) to a depth so that the underside (18) of the cap portion (14) imbeds into the sealant material (38) for providing a sealed connection between the underside (18) of the cap (14) and the fluidized sealant material (38) residing in the joint and on surfaces of the adjacent blocks (30,32) .
7. The improved cap (10) in claim 6, wherein the sealant material (38) comprises caulking.
8. The improved cap (10) in claim 6, wherein the underside (18) of the cap (14) increases the

area for the sealant (38) to adhere to, improving bonding between the cap (10) and the stones and strengthening the seal between the two.

9. The improved cap (10) in claim 6, wherein the cap (10) comprises a continuous strip of flexible material extending uninterrupted over the joint which needs to be sealed.

10. A method of sealing a joint between adjacent building blocks (30,32), comprising the following steps:

- a) filling the joint with a fluidized sealing material (38) such as caulking (38) ;
- b) providing a cap (10) , the cap (10) having a cap portion (14) and a downward depending leg portion (16) ;
- c) inserting the leg (16) portion down in to the fluidized sealing material (38) to a point that an underside (18) of the cap (14) portion makes sealing contact with the fluidized sealing material (38) ;
- d) providing a plurality of ridges (22) , which define a plurality of channels (24) there between on an underside (18) of the cap portion (14) , the ridges (22) and channels (24) increasing the area on the underside (18) of the cap (10) for the sealant (38) to adhere to, improving the bond between the cap (10) and the stones (30,32) and strengthening the seal between the two.

11. The method in claim 10, further comprising the step of removing the excess sealant material (38) from around the cap (10) before the sealant (38) completely sets.

12. The method in claim 10, the insertion of the leg portion (16) of the cap (10) down into the sealing material (38) decreases the size of a joint by one half therefore defining two joint spaces, rather than a single space.

(6) ISSUES:

(i) Are claims 1 - 12 patentable over Marble (U. S. Patent No. 2,016,968) in view of Jobe et al. (U.S. Patent No. 6,253,514) and Barton, et al. (U. S. Patent No. 5,088,260.)

(ii) Are Claims 1-12 patentable over Marble (U.S. Patent 2,016,968) in view of any of Hahn (U.S. Patent 6,228,507); Treister et al. (U.S. Patent 6,170,214); Negola et al. (U. S. Patent 6,161,353); Parkinson (U.S. Patent 5,715,643); Boyce (U. S. Patent No. 6,170,214); Negola et al.

(U.S. Patent No. 6,161,353); Parkinson (U.S. Patent 5,715,643); Boyce (U.S. Patent 5,667,334); Speer et al. (U. S. Patent 5,460,115); Hughes (U.S. Patent 5,197,819); Montalbano (U.S. Patent 5,078,358); and/or Winter, IV (U.S. Patent 4,833,855) under 35 U.S.C. § 103?

(7) GROUPING OF THE CLAIMS:

The rejected claims do not stand or fall together. Based on the references cited and arguments made by the Examiner, the claims are grouped together in particular combinations in part (8) for convenience. Applicant reserves the right to regroup the claims or to argue the patentability of each claim individually should new references be cited or new arguments or rejections be made.

(8) ARGUMENT:

Claims 1 - 12 are patentable over Marble (U. S. Patent No. 2,016,968) in view of Jobe et al. (U.S. Patent No. 6,253,514) and Barton, et al. (U. S. Patent No. 5,088,260.)

Claims 1 - 12 are patentable over Marble (U.S. Patent 2,016,968) in view of any of Hahn (U.S. Patent 6,228,507); Treister et al. (U.S. Patent 6,170,214); Negola et al. (U. S. Patent 6,161,353); Parkinson (U.S. Patent 5,715,643); Boyce (U. S. Patent No. 6,170,214); Negola et al. (U.S. Patent No. 6,161,353); Parkinson (U.S. Patent 5,715,643); Boyce (U.S. Patent 5,667,334); Speer et al. (U. S. Patent 5,460,115); Hughes (U.S. Patent 5,197,819); Montalbano (U.S. Patent 5,078,358); and/or Winter, IV (U.S. Patent 4,833,855).

Before addressing the primary reference of Marble, it is worth noting that in the previous first and final office actions, the Examiner cited a patent to Richter in combination with Marble. It was argued by applicant that Richter was non-analogous art and therefore an improper reference. The Richter patent concerned reflectors studs for roads, and was not at all related to or suggestive of the present invention. The Richter patent was not cited in the current office action, but has been withdrawn by the Examiner.

The Marble patent teaches the use of bonding material between adjacent building blocks which are subject to expansion and erosion. However, Marble failed to address the movement of the entire joint on a different plane. The Examiner, however, noted that although the Marble patent disclosed a cap adjacent blocks with sealant material, Marble did not teach or suggest the ridges to increase the bonding area by 50% on the underside of the cap portion, which greatly improves the

ability of the cap to protect the joints. Column1, line 36 of Marble states "The plastic bonding materials or joint fillers now used..." The use of plastic or other types did not allow adherence to the surface until modern sealants were developed. The use of the ridges as claimed in applicant's invention, allows the cap to become an integral part of the joint, and not merely rest on top of the joint. This allows for not only expansion and contraction, but also movement of the entire joint in a different plane. Without the ridges, the caps pulled away from the stone. The Marble patent prevented water intrusion caused by expansion and contraction of the bonding material. The fact that the present invention teaches elasticity, rather than a plastic member, allows it to integrally adhere to the joint and expand and contract with the joint.

Case Law Regarding Non-Analogous Art

Before the discussing the secondary patents cited by the Examiner, in combination with the primary reference, Marble , applicant asserts that an important principle covers the secondary patents cited against the claims. In short, most of the art cited, as will be discussed below, should be considered non-analogous art. It is well known in the case law that for art to be analogous art, it must at least suggest the invention, which this art does not. *In re Oetiker*, 977 F. 2d 1443, 24 USPQ 2d 1443, 1445 (Fed. Cir. 1992), stands for the proposition that "...a prior art reference must either be in the field of applicant's endeavor, or if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as the basis for rejection of the claimed invention."

Furthermore, "[T]hat all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art." *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865, 870 (CAFC 1983). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under [35 U.S.C.] Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems v. Montefiore Hospital*, 221 USPQ 929, 933 (CAFC 1984) and cases cited therein (emphasis in original). Applicant has carefully examined the patents cited, and can find neither a teaching nor

suggestion why it would be obvious to undertake the combination as claimed in the present invention.

To be specific, "[t]here is nothing in the prior art references, either singly or in combination, 'to suggest the desirability, and thus the obviousness,' of designing" an improved cap for sealed joints between adjacent blocks having a flexible body member which comprises a first cap portion and a leg portion; a plurality of ridges positioned on an underside cap portion, having a plurality of channels there between, the ridges further defining an increased area on the underside of the cap for sealant to adhere to; and the leg portion insertable into fluidized sealant material within the joint between the adjacent blocks, to a depth so that the underside of the cap portion imbeds into the sealant material for providing a sealed connection between the underside of the cap and the fluidized sealant material residing in the joint and on an upper surfaces of the adjacent blocks, or a method of applying same. In re Deminski, 230 USPQ 313, 315 (CAFC 1986) and cases cited therein (emphasis in original).

Applying the Non-analogous Art Standard to Marble/Jobe/Barton Combination

In the combination of Marble with Jobe et al., and Barton, the Examiner asserts that the '514 Jobe patent teaches ridges positioned on the underside of the cap portion to accommodate adhesive. In column 5, lines 45-46 state "... the shoulders 32 lay substantially flat along the edges of the joint. The other channel 38 is for receiving an adhesive." Applicant asserts that first the Jobe patent is teaching a pre cured caulk joint system, which does not indicate any types of ridges, particularly at the point noted by the Examiner. In combining the Marble and Jobe patents with Barton '260 patent, the Examiner cites column 3, lines 39 - 42 which state in part "This adhesive, given the fact that there is increased surface area by virtue of the bevelled edge 24, promotes improved adhesive strength when the adhesive sets." A reading of Barton does not indicate that the beveled edge has any type of ridges which would help increase surface area in the adhesion process. Furthermore, Barton is a patent addressing a system for joining structural panels and is not analogous to the art as taught by the present invention, as required *In re Oetiker, supra*.

Applying the Non-analogous Art Standard to the Other Section 103 References

Further, the Examiner rejected claims 1 - 12 under a series of patents in combination with Marble. Applicant will address these individually. Applicant first reiterates and adopts his

arguments that made earlier in this response in the Marble/Jobe/Barton combination of references. The Examiner cited the Hahn '507 patent, which is a patent entitled "Ornamental Plastic Crown Molding." Applicant would assert that crown molding is a stationary molding which is placed at the juncture between the ceiling and the wall. There is neither expansion nor contraction which is undertaken in crown molding, and even though there may be shallow groves and deep groves, as cited by the Examiner, the subject matter of this patent does not pertain to the subject matter of the present invention, an improved cap sealer for caulked joints, and would be considered non-analogous art.

Turning now to Marble in combination with Treister '214 patent, entitled "Cladding System," once more, this system is completely unrelated to the present invention, and addresses a complicated system to secure a cladding material panel to a building structure including upper and lower bracket members. Applicant would assert that the system should be considered non-analogous art not pertinent in suggesting or teaching the present invention as claimed.

In combining Marble with Negola et al '353 patent, entitled "Backerboard for Ceramic Tile And the Like," relates to placement of ceramic tiles on a floor surface. Once more, there is a rigid background on ceramic tiles when they are placed and glued down. However, ceramic tiles are being placed upon a structure which is secure and does not move as with the adjacent blocks as taught in using the present invention. Therefore, one would not refer to the '353 patent as being analogous art and fails to suggest the combination as taught in the claims of the present invention.

Reference is now made to the Parkinson '643 patent, entitled "Automotive Space Frame Joining System." Simply by its title, this patent addresses a space found in an automobile structure, such as a space frame or an assembly for joining automobile chassis members to form automobile space frame structures. It goes without saying that this is perhaps the most non-analogous art cited by the Examiner, and fails to suggest or teach the combination of the present invention in combination with Marble.

In combining the Marble patent with the Boyce '334 patent, entitled "Base for Roadway Marker," applicant would assert that this is an improper reference on two grounds. First, there are no ridges found in this base for roadway marker. If the Examiner is referencing to members 44, these are strengthening ribs which do not teach part of the combination of the present invention.

Secondly, as with the '643 patent, a base for a roadway marker constitutes art which is non-analogous art vis-a-vis the present invention.

In the Speer et al '115 patent, entitled "Temporary Roadway Marker", in combination with Marble, applicant fails to see the pertinence of this reference. This is a reference which may show a parallel groove 16 or sharp pointed tooth 18 which claim to attach the roadway marker to the roadway surface. However, one would note that this patent is specifically addressing a roadway marker which is in no way analogous to the combination of the present invention. Therefore, this is an improper reference.

In regard to the Hughes '819 patent in combination with Marble, this patent is entitled "Mounting Base for Highway Markers." Again, as with the '115 patent noted earlier, this patent pertains to a particular type of apparatus for attaching a flexible marker shaft to a roadway. In reviewing the patent, applicant could not find any of the so called ridges as noted by the Examiner and if so, the operation of this apparatus is in an art that is unrelated to the present invention.

In the combination of Marble with the Montalbano '538 patent again, this is a "Base for Roadway Marker and Method for Making Same." Again, applicant would argue that the manner that the apparatus is claimed and disclosed in this patent is in an art area that is totally unrelated to the present invention and again would suggest non-analogous art.

In citing the Winter, IV '855 patent in combination with Marble entitled "Prefabricated Panel Having a Joint Thereon," applicant would assert that of the many joints taught by that particular patent (for example in figure 4) nowhere in the patent is it taught that ridges are formed on the undersurface of a cap member in order to allow the member better adhesion between two adjacent blocks. Therefore, not only does this patent not contain ridges in the combination as claimed in the present invention, but the patent addresses a joint which is a prefabricated joint of adjoining panels, not adjacent blocks, and would be considered non-analogous art.

Again, applicant would make note of the *In re Oetiker, supra*, which stands for the proposition that "a prior art reference must either be in the field of applicant's endeavor, or if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as the basis for rejection of the claimed invention." (Emphasis underlined).

None of the references when combined with Marble teach the present invention.

Furthermore, many of the references as noted earlier, do not comply with the standards as set forth by *In re Oetiker, supra*, and therefore should not be used in combination in order to render the claims of this patent application unpatentable.

Applicant would further note that in reviewing the various patents as cited by the Examiner, not one of the prior art patents reference Marble as prior art during the examination of the patent. That applicant would assert, is clear evidence that Marble is addressing a problem which is related the present invention, but, by itself, Marble does not disclose and claim the entire combination of the present invention, and none of the patents cited in combination with Marble suggest that combination as analogous art. Therefore, claims 1-12 are therefore patentable over the art.

CONCLUSION:

For the foregoing reasons, applicant respectfully submits that all claims in the application are allowable. A Notice of Allowance is hereby respectfully requested.

TELEPHONE CONFERENCE INVITATION:

Should the Examiner or any member of the Board feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the telephone number listed below.

PETITION FOR EXTENSION OF TIME:

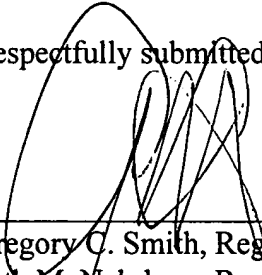
Applicant hereby petitions the Commissioner under 37 C.F.R. § 1.136 for any extension of time necessary to render this Appeal Brief timely filed, and asks that the fee for any such extension be charged to Deposit Account No. 50-0694.

FEES:

A \$ 160.00 check for the fee required by 37 C.F.R. § 1.192(a) and § 1.17(f) is enclosed.

Please charge any additional fees due or credit any overpayment to Deposit Account No. 50-0694.

Respectfully submitted,



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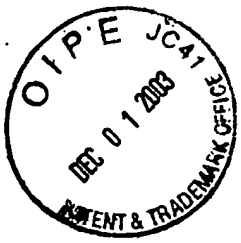
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(9) APPENDIX:
CLAIMS ON APPEAL:

1. An improved cap for sealed joints between adjacent blocks, comprising:
 - a) a flexible body member, comprising a first cap portion and a leg portion;
 - b) a plurality of ridges positioned on an underside cap portion, having a plurality of channels there between, the ridges further defining an increased area on the underside of the cap for sealant to adhere to;
 - c) the leg portion insertable into fluidized sealant material within the joint between the adjacent blocks, to a depth so that the underside of the cap portion imbeds into the sealant material for providing a sealed connection between the underside of the cap and the fluidized sealant material residing in the joint and on an upper surfaces of the adjacent blocks.
2. The improved cap in claim 1, wherein the cap is constructed of material having the characteristics of lead.
3. The improved cap in claim 1, wherein the leg member further comprises a pointed end having shoulder members for adhering within the sealant material.
4. The improved cap in claim 1, wherein the plurality of ridges and channels on the underside of the cap portion define a means for adhering to the fluidized sealant and the upper portion of the adjacent blocks for withstanding movement and preventing damage to the sealed joint.
5. The improved cap in claim 1, wherein the cap may be positioned to seal a joint between horizontal and vertical surfaces.
6. An improved cap for sealed joints between adjacent building members, comprising:
 - a) a flexible body member, comprising a first cap portion having a first smooth upper surface, an undersurface, and a leg portion extending down from the undersurface;
 - b) a plurality of ridges positioned on the undersurface of the cap portion, defining a plurality of channels there between, the plurality of ridges and channels increasing the surface area on the underside of the cap by around 50% for the sealant to adhere to, thus strengthening the seal between the cap and the concrete or stone blocks the cap is set upon;
 - c) fluidized sealant material placed within the joint between the adjacent building members;
 - d) the leg portion insertable into the fluidized sealant material to a depth so that the underside

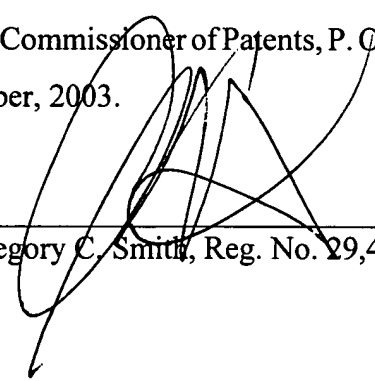
of the cap portion imbeds into the sealant material for providing a sealed connection between the underside of the cap and the fluidized sealant material residing in the joint and on surfaces of the adjacent blocks.

7. The improved cap in claim 6, wherein the sealant material comprises caulking.
8. The improved cap in claim 6, wherein the underside of the cap increases the area for the sealant to adhere to, improving bonding between the cap and the stones and strengthening the seal between the two.
9. The improved cap in claim 6, wherein the cap comprises a continuous strip of flexible material extending uninterrupted over the joint which needs to be sealed.
10. A method of sealing a joint between adjacent building blocks, comprising the following steps:
 - a) filling the joint with a fluidized sealing material such as caulking;
 - b) providing a cap, the cap having a cap portion and a downward depending leg portion;
 - c) inserting the leg portion down in to the fluidized sealing material to a point that an underside of the cap portion makes sealing contact with the fluidized sealing material;
 - d) providing a plurality of ridges, which define a plurality of channels there between on an underside of the cap portion, the ridges and channels increasing the area on the underside of the cap for the sealant to adhere to, improving the bond between the cap and the stones and strengthening the seal between the two.
11. The method in claim 10, further comprising the step of removing the excess sealant material from around the cap before the sealant completely sets.
12. The method in claim 10, the insertion of the leg portion of the cap down into the sealing material decreases the size of a joint by one half therefore defining two joint spaces, rather than a single space.



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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief Patents, Board of Patent Appeals and Interferences, Commissioner of Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of November, 2003.



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